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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/633,910	08/04/2003	Shiro Miyamori	788_110	7558
25191	7590	09/23/2004	EXAMINER	
BURR & BROWN PO BOX 7068 SYRACUSE, NY 13261-7068			JIMENEZ, MARC QUEMUEL	
			ART UNIT	PAPER NUMBER
			3726	

DATE MAILED: 09/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/633,910

Applicant(s)

MIYAMORI ET AL.

Examiner

Marc Jimenez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 03082004,08042003.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 1-10** are rejected under 35 U.S.C. 103(a) as being unpatentable over Itoh et al. (6,283,904) in view of Narita et al. (JP 2002-40755A).

Itoh et al. teach an electrically conductive roll which includes a shaft body **2** and which includes at least a conductive elastic layer **4** formed by extrusion (col. 4, line 5) on an outer circumferential surface of the shaft body **2**, wherein the conductive elastic layer **4** being formed of a conductive rubber composition which includes rubber material (col. 4, lines 28-29) and at least one conductive agent (col. 4, line 38).

Itoh et al. teach the invention cited with the exception of the conductive elastic layer having a thermoplastic resin with a melting point in a range from 40-100 degrees C and added in an amount of 5 to 50wt% of the total amount of rubber material and thermoplastic resin.

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Narita et al. teach a conductive elastic layer with thermoplastic resin (see paragraph [0024] of the English translation of Narita et al.).

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of Itoh et al. with a thermoplastic resin, in light of the teachings of Narita et al., in order to reduce temperature and humidity dependency as suggested by Narita et al. at paragraph [0024] and as suggested by Itoh et al. at col. 4, lines 22-24 who teaches that it is also possible to add any other kind of agent besides the conductive agent.

Regarding the limitations directed to the melting point range of a particular type of thermoplastic material used, the use of polycotener, or the ranges in amounts of thermoplastic added, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have selected the claimed material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. See also *Ballas Liquidating Co. v Allied industries of Kansas, Inc.* (DC Kans) 205 USPQ 331. Furthermore, it would have been obvious to one of ordinary skill in the art at the time of the invention, to have used the claimed ranges, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Regarding claim 2, Itoh et al. uses the claimed materials in col. 2, line 17.

Regarding claim 6, Itoh et al. teach using carbon black (col. 2, line 42).

Regarding claims 7-8, Itoh et al. teach using silica (col. 3, line 32) in the claimed ranges of claim 8.

Regarding claim 9, Itoh et al. teach the claimed volume resistivity in col. 6.

Regarding claim 10, Itoh et al. teach the claimed thickness (col. 3, lines 64-65).

Double Patenting

4. **Claims 1-10** are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of copending Application No. 10/649,053. Although the conflicting claims are not identical, they are not patentably distinct from each other because '053 teaches an electrically conductive roll which includes a shaft body (claim 1, lines 3 of '053) and which includes at least a conductive elastic layer (claim 1, line 6 of '053 or "resistance adjusting layer") formed by extrusion (claim 2 of '053) on an outer surface circumferential surface of the shaft body, wherein the conductive elastic layer is formed of a conductive rubber composition which includes a rubber material, a thermoplastic resin having crosslinkable double bonds (claim 1, lines 7-8 of '053) and a melting point in a range from 40 to 100 degrees C (claim 6 of '053), and at least one conductive agent (claim 1, line 12 of '053).

Regarding the limitation "the thermoplastic resin being included in an amount of 5 to 50% of a total amount of the rubber material and the thermoplastic resin, It would have been obvious to one of ordinary skill in the art at the time of the invention, to have made the prior art at the claimed ranges, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Contact Information

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc Jimenez whose telephone number is (703) 306-5965. The examiner can normally be reached on Monday-Friday between 5:30 a.m.-2:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (703) 308-1789. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Marc Jimenez
Patent Examiner
AU 3726

MJ

September 18, 2004